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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,921

09/30/2005

Gunter Ziegler

RSW 85162 US

8579

65159 7590 03/31/2008  
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EXAMINER

ELLIS, SUEZU Y

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

03/31/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,921	<b>Applicant(s)</b> ZIEGLER ET AL.	
	<b>Examiner</b> Suezu Ellis	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 2-21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,22,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/16/05, 5/16/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group II (claims 22-29) in the reply filed on March 18, 2008 is acknowledged.

Claims 2-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 18, 2008.

Applicant's election with traverse of invention IIa (claims 22, 23 and 25-29) in the reply filed on March 18, 2008 is acknowledged. The traversal is on the ground(s) that claim 24 (invention IIb) is within the elected "species" at least to the extent that it is dependent from claim 23. This is not found persuasive because claims 23 and 25-28 contain the mutually exclusive subject matter regarding the particulars of the metal ions, which is not present in claim 24, and therefore is the basis for inventions IIa and IIb being related products.

The requirement is still deemed proper and is therefore made FINAL.

Examiner notes that claims 4-29 are still improper multiple dependent claims, as noted in the restriction requirement mailed February 14, 2008, and therefore, the elected invention will be examined as follows:

Claims 1, 22 and 23 will be examined on the merits.

Claims 2-21 are drawn to the non-elected invention and therefore will be withdrawn from further consideration.

Claim 24 is drawn to a non-elected related product and therefore will be withdrawn from further consideration.

Claims 25-29 are improper multiple dependent claims and therefore cannot be examined on the merits.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement filed March 16, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement (IDS) submitted on May 16, 2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Objections***

Claims 25-29 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 22, 23 and 25-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "optionally" and "and/or" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). While the term "optionally" is not *per se* indefinite as set forth in MPEP 2173.05(h) III., applicant's claim language recites "and optionally water and/or an acid with metal salts and/or with organometallic compounds...". It is unclear if the acid and the organometallic compounds are optional ingredients as well. Further, it is unclear if the and/or is to be in the alternative form. For examination purposes, the water, acid with metal salts, and organometallic compounds are all considered to be optional ingredients.

Claims not specifically addressed are indefinite due to their dependency.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Masuhara et al. (US 2001/0002994).

With respect to claims 1 and 22, Masuhara et al. discloses titanium oxide coating on an implant prepared by adding a preparation containing an organic solvent and an organometallic titanium oxide precursor, and applying the preparation prepared onto an implant, and drying the coating [0033], [0038], [0101], [0132], [0146].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masuhara et al. (US 2001/0002994) in view of Pratt et al. (US 4,849,223).

With respect to claim 23, Masuhara et al. addresses all the limitations of claims 1 and 22, and further discloses the inclusion of metal particles or metal salts of silver [0136]. Masuhara et al. fails to expressly disclose an organometallic compound that

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disperses metal ions homogeneously in the preparation, wherein the metal ions exert an anti-microbial or antibacterial effect, respectively, under physiological conditions. Pratt et al. discloses a coating comprising metallic silver combined with titanium dioxide that release silver ions into surrounding fluids or tissues (col. 2, lines 33-41, 51-68). It would have been obvious to one of ordinary skill in the art to include an organometallic compound that disperses metal ions homogeneously in the preparation in order to provide a sustained antibacterial effect.

#### ***Telephone/Fax Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suez Ellis whose telephone number is (571) 272-2868. The examiner can normally be reached on 8:30am-5pm (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Kennedy can be reached on (571) 272-4948. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SE

*/Sharon E. Kennedy/  
Primary Examiner, Art Unit 1615*